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10/569,494	02/27/2006	Motoi Totiba	1254-0304PUS1	3470
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EXAMINER				
RIGGS II, LARRY D				
ART UNIT		PAPER NUMBER		
1631				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/569,494

Applicant(s)

TOTIBA ET AL.

Examiner

LARRY D. RIGGS II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's amendments filed 10 August 2009 are acknowledged and entered.

Status of Claims

Claim 14 is cancelled. Claims 1-13, 15 and 16 are currently pending and under consideration.

Withdrawn Rejections/Objections

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-13, 15 and 16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The recent en banc decision regarding *Bilski v. Warsaw* (2008) set forth that a process is patent-eligible if (1) it is tied to a particular machine or apparatus or (2) it transforms a particular article into a different state or thing.

The instant claims are drawn to a method for visualizing correlation data concerning two biological events or correlation and feature data in a matrix format as well as a general computer program product containing a program to said method. The instant claims are drawn to the abstract process steps of acquiring correlation and feature data, processing the correlation and feature data, and displaying the correlation and feature data.

The instant claims do not recite or inherently involve any transformation of an article, or recite any limitation that ties the recited abstract process to any particular machine or apparatus.

Further, displaying said interval scores is an insignificant post-solution activity. Nominal or token recitations will not suffice, E.g. displaying, inputting, obtaining, See *Ex parte Langemyr* (May 28, 2008). Applicants are cautioned against introduction of new matter in an amendment.

Claims 15 and 16 are drawn to a computer readable medium comprising instructions for visualizing correlation data. The instant specification does not explicitly define the scope of the limitation of "computer readable medium." The computer program product/computer readable media is not limited to a physical embodiment and may read on carrier waves and other nonstatutory media. See, e.g., *In re Nuijten*, Docket no. 2006-1371 (Fed. Cir. Sept. 20, 2007)(slip. op. at 18)("A transitory, propagating signal like Nuijten's is not a process, machine,

manufacture, or composition of matter.' ... Thus, such a signal cannot be patentable subject matter.").

For these reasons, claims 1-13, 15 and 16 are considered non-statutory subject matter.

Response to Arguments

Applicant's arguments filed 10 August 2009 have been fully considered but they are not persuasive.

Applicants argue that that the instant claims meet both prongs of the machine-or-transformation test because the method is performed "in a suitably programmed computer" and claim 15 is directed to a computer-readable programmable recording medium in with a program....is stored, thus meeting the tied to a particular machine prong of the test. Applicants argue that the tangible visual depiction of a relationship between biological events in instant claims is like the transformation of Abele and thus suffices from the transformation of a particular article prong. Applicants argue the instant claims do not pre-empt a natural phenomenon.

Applicants arguments are not persuasive. The instant method claims 1-13 are merely abstract process steps that do not have a tie of a particular step of the method to a particular machine. Reciting that a method is performed by a suitably programmed computer in the preamble does not TIE a specific step of the method to a particular machine or apparatus. A specific step of the method must be tied to a particular machine or apparatus. The two prong analysis

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recited in *In re Bilski* is only applicable to method claims, not with the computer product claims of 15 and 16. A tangible visual depiction of a relationship of events is not a transformation of a particular article or thing, as in *Abele*. There is no transformation of one type of data into a different article or thing.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a

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later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-10, 12, 13, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ge et al. (Nature Genetics, 2001, 29, 482-486) in view of Cras et al. (US 2002/0091681).

The instant claims provide a method for visualizing correlation data concerning two biological events or the correlation data and feature data regarding each event in a matrix format, the method comprising acquiring and processing correlation and feature data, displaying correlation data concerning biological events of the same or different kinds, or the correlation data and feature data regarding each biological event in (a) one of a plurality of prepared data display formats and at (b) one of a plurality of prepared summarization levels, both of which are selected either manually or automatically depending on the number of data items in desired display data, to visualize the correlation and feature data.

Regarding claims 1 and 9, Ge et al. acquired protein-protein pair (feature data) and corresponding genes (correlation data) from three experiments, (page 485, right column, second paragraph) and processed the correlation and feature data, (page 485, right column, last paragraph – page 486). Ge et al. shows a transcriptome-interactome correlation mapping strategy of displaying pair-wise combinations between the clusters of an expression profiling experiment, with numbers assigned to each cluster in rows and columns of the matrix along with

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the number of genes each cluster contains in parenthesis, wherein the table on the right shows protein interaction pairs together (feature data) with the expression cluster to which the corresponding genes belong (correlation data), wherein these expression clusters and corresponding genes are displayed simultaneously, (page 482, right column, last paragraph - page 483, left column, first paragraph; Figure 1).

Ge et al. does not show summarization levels.

Cras et al. shows a system and method for creating an analytical report on top of a multidimensional data model built on top of a relational or multidimensional database, wherein based on rules or queries a summarization of levels of data may be supplied, (paragraphs 9-13, 48-70, 110-116, 120-121, 129, 174).

Regarding claim 2, Ge et al. shows a table of an interaction pair (A), a table of clusters of an expression profiling experiment (B), and a table showing the probability for obtaining at least k observed groups in the intraccluster region by chance (C) (Figure 1; Table 1).

Regarding claim 3, Ge et al. shows a two-dimensional matrix by organizing clusters derived from a set of related transcriptional profiling experiments into tow identical axes, wherein pairs of genes whose product can int4eract, according to the clusters to which each gene belongs, (correlation info); For each square, an index of protein interaction density (PID) as the ratio of the number of observed protein interaction pairs to the total number of possible pair-

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wise combination of protein pairs is calculated (attribute information), (page 483, left column, first paragraph).

Regarding claim 4, Ge et al. shows transcriptome-interactome correlation maps, with calculated protein interaction density (PID) for each square in the matrix as the ratio of interaction of pairs assigned to the square (IP) over the total number of protein pairs possibly formed by combination of the genes in the square (PP) and running diagonally from left to right and indicated by color, (Figure 2).

Regarding claim 5, Ge et al. shows data reduced to a character type (protein interaction pairs) and numeric value type (numbers assigned to each cluster, number of genes each cluster contains, (Figure 1).

Regarding claims 6 and 7, Ge et al. shows character type (protein interaction pairs) and numeric value type (numbers assigned to each cluster, number of genes each cluster contains in a layered structure, a keyword (ORF), rounding values to significant digits and signs or colors indicating ORF pairs, (Figures 1-3, Table 1).

Regarding claim 8, Cras et al. shows a mechanisms which the results of a multidimensional query are processed such that their format and contents accurately reflect the semantics of an entity/relationship report specification, such that the tabular and cross-tabulated reports may be executed using an online analytical programming query, (paragraphs 110-116).

Regarding claim 10, Ge et al. shows protein-protein interactions and clustering analysis data sets of cell cycle-regulated genes, meiosis-regulated

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genes and cell stress-regulated genes, (page 485, right column, second paragraph).

Regarding claims 12 and 13, Ge et al. shows that a feature quantity common to members of the cluster are the proteins produced by the genes of the cluster, interact with one another, (abstract, Figure 1). Ge et al. shows a plurality of genes that encode a plurality of interacting proteins wherein these PIDs are expressed in color, (Figures 2-3).

Regarding claim 15, Ge et al. provides a k-means algorithm for clustering analysis with the yeast cell-cycle expression data, (page 483, left column, last paragraph).

Cras et al. shows a computer readable medium having computer readable code embodied for use in the execution of a method of transforming results of a query into results of a report, (paragraph 108, claim 13).

Regarding claim 16, Ge et al. acquired protein-protein pair (feature data) and corresponding genes (correlation data) from three experiments, (page 485, right column, second paragraph) and processed the correlation and feature data, (page 485, right column, last paragraph – page 486). Ge et al. shows a transcriptome-interactome correlation mapping strategy of displaying pair-wise combinations between the clusters of an expression profiling experiment, with numbers assigned to each cluster in rows and columns of the matrix along with the number of genes each cluster contains in parenthesis, wherein the table on the right shows protein interaction pairs together (feature data) with the expression cluster to which the corresponding genes belong (correlation data),

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wherein these expression clusters and corresponding genes are displayed simultaneously, (page 482, right column, last paragraph - page 483, left column, first paragraph; Figure 1). Ge et al. shows a table of an interaction pair (A), a table of clusters of an expression profiling experiment (B), and a table showing the probability for obtaining at least k observed groups in the intracluster region by chance (C) (Figure 1; Table 1). Ge et al. shows that a feature quantity common to members of the cluster are the proteins produced by the genes of the cluster, interact with one another, (abstract, Figure 1). Ge et al. shows a plurality of genes that encode a plurality of interacting proteins wherein these PIDs are expressed in color, (Figures 2-3).

Cras et al. shows a system and method for creating an analytical report on top of a multidimensional data model built on top of a relational or multidimensional database, wherein based on rules or queries a summarization of levels of data may be supplied, (paragraphs 9-13, 48-70, 110-116, 120-121, 129, 174). Cras et al. shows a computer readable medium having computer readable code embodied for use in the execution of a method of transforming results of a query into results of a report, (paragraph 108, claim 13).

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to modify the transcriptome-interactome correlation mapping method by Ge et al. with the summarization levels of Cras et al. because Cras et al. shows the importance of clustering (grouping) data based on attributes into a hierarchy of levels and aggregating fact values at different levels of summarization, and a person of ordinary skill in the art would understand that

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visualizing data with the aid of levels of summarization would enable better visualization of the correlation of data, (Cras et al., paragraph 172-176). Likewise, it would be obvious that protein-protein interactions encompass protein-peptide interactions wherein peptides encompass compounds of low molecular weight. Therefore, one of ordinary skill in the art would recognize the claimed process as a combination of routine applications that are well known the art that and produce no more than expected results.

Response to Arguments

Applicant's arguments filed 10 August 2009 have been fully considered but they are not persuasive.

Applicants argue that Ge et al. does not disclose a plurality of display formats. Ge does not select one display and one summarization format from a plurality displays and formats. Cras et al. does not remedy these deficiencies because Cras et al. does not show a plurality of formats, wherein a plurality of summarization levels are prepared. The cited art does not make the instant invention obvious. Regarding claim 11, Ge, Cras and Artymiuk do not disclose the plurality of summarization levels and plurality of display formats discussed above.

Applicants arguments are not persuasive.

Ge et al. shows a plurality of display formats, e.g. 2D and 3D expression cluster matrix, (See Figure 1). Cras et al. shows a plurality of prepared summarization levels, as required by the instant claims, (e.g. paragraphs 11, 12, 48-70). There are no deficiencies by Ge et al. and Cras et al. Likewise there are

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no deficiencies in Ge et al. in view of Cras et al. and further in view of Artymiuk et al. All limitations are met by the cited art.

Claims 1-13, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ge et al. (Nature Genetics, 2001, 29, 482-486) in view of Cras et al. (US 2002/0091681) as applied to claims 1-10, 12, 13, 15 and 16 above, and further in view of Artymiuk et al. (J. Mol. Biol., 1994, 243, 327-344).

The instant claim 11 depends from claim 1 with the extra limitation that as the biological events, a structural unit is defined on the basis of atoms in a molecule or a set of atoms in a molecule for each molecule in a complex of one or more molecules, a representative position of the structural unit is defined on the basis of the coordinates of atoms of which the structural unit is composed, and information about the distance between the representative positions of the structural units is displayed in the cells in the matrix, said matrix having each of the structural units as elements in the rows and columns thereof.

Ge et al. and Cras et al. are applied to claims 1-10, 12, 13, 15 and 16 above.

Regarding claim 11, Ge et al. and Cras et al. do not show a matrix with rows and columns of cells encompassing structural units of molecules, wherein the structural unit are atom(s) in a molecule, with information about distances between structural units.

Artymiuk et al. shows a matrix with rows and columns of cells encompassing structural units of a protein, wherein the structural units are the atoms of amino acids (Histidine 57, Serine 195 and Aspartate 102) encompassing a serine-protease catalytic triad, and providing distances between the respective structural units, (page 331; Figures 2-3).

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to modify the transcriptome-interactome correlation mapping method by Ge et al. with the summarization levels of Cras et al. and the search matrix of structural units with respective distances by Artymiuk et al. because a search matrix is a subgraph that is searched for in graphs that contains the necessary parts as required for a particular search pattern (structural units) and allows one skilled in the art to minimize the storage overhead and greatly reduce the input-output overheads that would be involved in reading large pre-calculated matrices, (Artymiuk, page 331, right column, penultimate paragraph).

Response to Arguments

Applicant's arguments filed 10 August 2009 have been fully considered but they are not persuasive.

Applicants argue that Ge, Cras and Artymiuk do not disclose the plurality of summarization levels and plurality of display formats discussed above.

Applicants arguments are not persuasive.

Ge et al. shows a plurality of display formats, e.g. 2D and 3D expression cluster matrix, (See Figure 1). Cras et al. shows a plurality of prepared summarization levels, as required by the instant claims, (e.g. paragraphs 11, 12,

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48-70). There are no deficiencies by Ge et al. and Cras et al. Likewise there are no deficiencies in Ge et al. in view of Cras et al. and further in view of Artymiuk et al. All limitations are met by the cited art.

Conclusion

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LARRY D. RIGGS II whose telephone number is (571)270-3062. The examiner can normally be reached on Monday-Thursday, 7:30AM-5:00PM, ALT. Friday, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie Moran can be reached on 571-272-0720. The

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fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LDR/
Larry Riggs
Examiner, Art Unit 1631

/Marjorie Moran/
Supervisory Patent Examiner, Art Unit 1631